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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,294	11/29/2000	Masashi Koshino	11P338920	8772

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EXAMINER

LELE, TANMAY S

ART UNIT	PAPER NUMBER
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2684

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DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,294

Applicant(s)

KOSHINO, MASASHI

Examiner

Tanmay S Lele

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 04 September 2003 have been fully considered but they are not persuasive.
2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the present invention compares, during the waiting operation, i.e., the period between calls;" "and then to automatically set a function, e.g., a call arrival tone and a call arrival tone level;" "when the radio communication terminal moves about, e.g. a trip from home to office," and "the radio communication terminal may automatically enter a high speed travel mode, ie one of several possible settings") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claims 1 –18, Applicant attempts to overcome the rejection by stating, "In contrast, the present invention compares, during the waiting operation, i.e., the period between calls when the terminal receives broadcast data and reception levels from a plurality of base stations, the broadcast data and reception levels with registered data corresponding to a preset location, in order to set a function corresponding to the preset location for incoming or received calls." Note that these limitations, in addition to the others cited above, do not appear in the claimed as presented or previously recited, and hence, because the Examiner is required to interpret the claims in the broadest reasonable manner under current examining practice, the

Examiner is not persuaded by the Applicant's arguments suggesting that the references do not teach or recite the claimed as presented.

3. In response to applicant's argument that "Therefore, Jokimies does not disclose, teach, or suggest at least the features of "comparing means for comparing, during said waiting operation, said broadcast data and said reception levels with said registered data in said storing unit" and "comparing, during said waiting, operation, said broadcast data and said reception levels with said registered data," as recited in claims 1 and 7," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In regards to claims 1 – 18, Applicant further attempts to overcome the rejection by stating, "Therefore, Jokimies does not disclose, teach, or suggest at least the features of "comparing means for comparing, during said waiting operation, said broadcast data and said reception levels with said registered data in said storing unit" and "comparing, during said waiting, operation, said broadcast data and said reception levels with said registered data," as recited in claims 1 and 7." Examiner respectfully disagrees that Jokimies is not capable of performing these functions. Note that Jokimies teaches of, as noted by Applicant in paper 9, page 13, that Jokimies teaches of checking at power-up and at the beginning of each call, its current location (note the subsequent discussion further relates to Jokimies invention, as noted

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beginning column 3, line 66 and ending column 4, line 14), which meet the claimed, "...during a waiting period..." as broadly interpreted. Note further that as known in the art, BCCH (Broadcast Control Channel) are initially received when entering a cell (broadcasting information such as cell and network ID, control channel structure, availability, ect) and thus must be received before call origination. Hence, because the Examiner is required to interpret the claims in the broadest reasonable manner under current examining practice, the Examiner is not persuaded by the Applicant's arguments suggesting that the references do not teach or recite the claimed as presented.

4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Further regarding claims 2 – 6 and 8 – 18, Applicant attempts to overcome the rejection by stating, "Nowhere does Kraft disclose, teach, or suggest when knowledge of the phone's position, which presumably corresponds to the claimed invention's radio communication terminal, is determined, e.g., at the initiation of a call. Hence, Kraft does not teach or suggest comparing, during said waiting operation, said broadcast data and said reception levels with said registered data, as described in claims 1 and 7." Note that as stated in the previous Office Action, Kraft was introduced and combined for the cited motivation for teaching of, "setting means..." (as noted in paper number 8, page 4 as an example; note some confusion exists as claims 1 and 7 are rejected under Jokimies only and hence it is assumed that these arguments are

in reference to claims 2 – 6 and 8 – 18). As noted above, it is believed that Jokimies does teach or recite the claimed as broadly interpreted.

Continuing, it is reverently believed that draft does allude to location, as noted for example starting column 1, lines 55 and ending column 2, line 12 (as concurred by Applicant in paper number 9, page 14) and hence it is again respectfully submitted that Kraft does, “suggest disclose, teach, or suggest when knowledge of the phone's position.” Hence, Examiner is not persuaded by Applicant’s arguments that the references, when combined for the cited motivation, do not teach, recite, or suggest the claimed as presented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 7, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Jokimies et al. (Jokimies, US Patent No. 6,526,267).

Regarding claims 1 and 7, Jokimies teaches of a radio communication terminal system and method which during a waiting operation receives broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising: a storing unit for storing broadcast data and reception levels received from said plurality of base stations, as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), when said radio communication terminal is located at a preset position and

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comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), during said waiting operation, said broadcast data and said reception levels with said registered data in said storing unit (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Regarding claim 19, Jokimies teaches of a radio communication system (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising: a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4); and a radio communication terminal according to claim 1 (as noted above in the rejection for claim 1).

Regarding claim 20, Jokimies teaches of a method of radio communication (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising: comparing during a waiting operation, broadcast data and reception levels from a plurality of base stations with registered data corresponding to a preset position (Figures 2 and 3 and starting column 3, lines 26 – 44 and starting column 3, line 66 and ending column 4, line 10).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 – 6 and 8 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Jokimies, US Patent No. 6,526,267) in view of Kraft et al. (Kraft, US Patent 6,463,278).

Regarding claims 2 and 8, Jokimies teaches of a radio communication terminal system

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and method which during a waiting operation receives broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing unit for storing broadcast data and reception levels received from said plurality of base stations, as registered data, when said radio communication terminal is in a preset presence located at a preset position and reception levels of these broadcast data as registered data (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), during said waiting operation, said broadcast data and said reception levels with said registered data in said storing unit (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels and said registered data, a preset function corresponding to the pertinent said registered data.

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels and said registered data, a preset function corresponding to the pertinent said registered data (column 1, lines 35 – 54 and Tables 1 – 3).

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function provisions, for the purposes of automatically setting user preferences in accordance with different environments (ie meetings, car use, ect.), as taught by Kraft.

Regarding claims 3 and 9, Jokimies teaches of a radio communication terminal system and method which during a waiting operation by receives broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing unit for storing broadcast data and reception levels received from said plurality of base stations, as registered data, when said radio communication terminal is located at a preset position (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), during, said waiting operation, the said broadcast data and said reception levels said registered data in said storing unit (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels, and said registered data, a preset function corresponding to said registered data, wherein said preset function includes at least one of a call arrival tone, a call arrival tone level, an out-of-home dealing function ON/OFF, and a call transfer function ON/OFF.

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels, and said registered data, a preset function corresponding to said registered data, (column 1, lines 35 – 54 and Tables 1 –3) wherein said preset function includes at least one of a call arrival tone, a call arrival tone level, an out-of-home dealing function ON/OFF, and a call transfer function ON/OFF (column 1, lines 35 – 54 and column 2, lines 57 – 68 and Tables 1 –3).

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function provisions, for the purposes of automatically setting user preferences in accordance with different environments (ie meetings, car use, ect.), as taught by Kraft.

Regarding claims 4 and 10, Jokimies teaches of a radio communication terminal system and method which during a waiting operation receives broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing unit for storing broadcast data and reception levels received from said plurality of base stations, as registered data, when said radio communication terminal is located at a preset position (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), in the during said waiting operation, said broadcast data said reception levels with said registered data in said storing unit (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels, and said registered data, a preset function corresponding to said registered data, and for restoring a preset default setting, when said comparing means does not detect coincidence between said broadcast data and said reception levels (note brackets are added for clarity; it is believed these limitations are met from the above cited passages).

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when said comparing means detects coincidence between said

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broadcast data and said reception levels, and said registered data, a preset function corresponding to said registered data (column 1, lines 35 – 54 and Tables 1 –3) and for restoring a preset default setting, when said comparing means does not detect coincidence between said broadcast data and said reception levels (column 1, lines 35 – 54 and Tables 1 –3 and column 4, lines 46 – 57).

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function provisions, for the purposes of automatically setting user preferences in accordance with different environments (ie meetings, car use, ect.), as taught by Kraft.

Regarding claims 5 and 11, Jokimies teaches of a radio communication terminal system and method which during a waiting operation receives broadcast data from a plurality of base stations (Figures 1, 3, and 4 and starting column 1, line 33 and ending column 2, line 4), comprising a storing unit for storing broadcast data and reception levels received from said plurality of base stations, as registered data, when said radio communication terminal is located at a preset position (Figure 3 and column 4, lines 38 – 46 and column 3, lines 4 – 24), and comparing means for comparing (Figures 2 and 3 and starting column 3, lines 26 – 44), in the during said waiting operation, said broadcast data and said reception levels with said registered data in said storing unit (as seen in Figures 3 and 4 and column 4, lines 46 – 54 and column 3, lines 4 – 24).

Jokimies does not specifically teach of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels, and said registered data, a preset function corresponding to said registered data, said preset function including at least one of a call arrival tone, a call arrival tone level, an out-of home dealing

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function ON/OFF, and a call transfer function ON/OFF, and when said comparing means does not detect said coincidence, restoring a preset default setting.

In a related art dealing with automatic telephone parameter selection, Kraft teaches of setting means for setting, when said comparing means detects coincidence between said broadcast data and said reception levels, and said registered data (column 1, lines 35 – 54 and Tables 1 –3) a preset function corresponding to said registered data, said preset function including at least one of a call arrival tone, a call arrival tone level, an out-of home dealing function ON/OFF, and a call transfer function ON/OFF (column 1, lines 35 – 54 and column 2, lines 57 – 68 and Tables 1 –3) and when said comparing means does not detect said coincidence, restoring a preset default setting (column 1, lines 35 – 54 and Tables 1 –3 and column 4, lines 46 – 57).

It would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection system, Kraft's automatic present function provisions, for the purposes of automatically setting user preferences in accordance with different environments (ie meetings, car use, ect.), as taught by Kraft.

Regarding claims 6, 13, 14, 15, 12, 16, 17, and 18, Jokimies in view of Kraft, teach all the claimed limitations as recited in claims 2 – 5 and 8 – 11, respectively. Kraft further teaches of wherein said setting means sets a high speed travel mode that prohibits reception of an arrived call when said broadcast data and said reception levels undergo frequent changes (column 4, lines 49 – 58, column 6, lines 24 – 31; note the modes as per Table 3).

Conclusion


9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanmay S Lele whose telephone number is (703) 305-3462. The examiner can normally be reached on 9 - 6:30 PM Monday – Thursdays and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay A. Maung can be reached on (703) 308-7745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.


Tanmay S Lele
Examiner
Art Unit 2684

tsl
June 25, 2004


NAY MAUNG
SUPERVISORY PATENT EXAMINER